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## REMARKS

### I. Status of the Claims

Claims 1, 2, 4-10, 21 and 22 are pending in the application and have been examined. Claims 1 and 21 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Cheng. Claims 4-10 and 22 stand rejected under §102(b) as allegedly anticipated by Hudson. Claim 2 stands rejected under 35 U.S.C. §102(a) and (e). Claims 4-10 and 22 are also rejected under 35 U.S.C. §112, second paragraph. The specific grounds for rejection, and applicant's response thereto, are set out in detail below.

### II. Objection to the Specification

The examiner has noted that sequence identifiers are lacking from the specification. Appropriate amendments have been provided; figures have been amended as well (above).

### III. Rejections Under 35 U.S.C. §102

#### A. *Cheng*

Claims 1 and 21 stand rejected under §102(b) as allegedly anticipated by Cheng. Applicants traverse the rejection.

The rejection depends upon the examiner's unsupported assertions that the sequence on Cheng's nucleic acid 5' to the CCCTT motif is either a (a) polypeptide tag encoding sequence, a terminator sequence, a fusible protein sequence or a sequence that is within some intron. The examiner has not identified a single polypeptide tag or fusible protein sequence encoded by this seven nucleotide segment (CGTGTCG), nor is it even plausible to suggest that 2 1/3 codons could encode such elements. Further, no intronic sequence or terminator with this sequence has been identified in the prior art. As such, the rejection is improper.

In the interest of advancing the prosecution, applicants provide an amended claim 1 that drops the recitation of an intronic sequence, thereby further limiting the claim. Reconsideration and withdrawal of the rejection is, therefore, respectfully requested.

**B. Hudson**

Claims 4-10 stand rejected under §102(b) as allegedly anticipated by Hudson. Applicants traverse the rejection. The Hudson reference does not provide a nucleic acid that satisfies the claim 4 limitation that the scissile strand topoisomerase I cleavage site is not more than 10 bases from the 3' end of the first nucleic acid. Thus, claim 4 cannot be anticipated by Hudson.

The examiner challenges this assertion by arguing that “what constitutes the end of the first nucleic acid and the beginning of the second nucleic acid is not set forth in the claims.” This does not make any sense. The adaptor may comprise first and second nucleic acids, *which are distinct molecules*. As discussed in claim 5, the claim that first introduces the second nucleic acid, this molecule may be *complementary* to the first nucleic acid. However, it is still distinct, as illustrated by the definition of complementary (page 4), which states that complementary molecules are a *pair* of single-stranded nucleic acids that anneal. Thus, any discussion of the second nucleic acid somehow impacting an interpretation of the structure of the first nucleic acid is off the mark. As such, applicants once again submit that it is clear that the Hudson reference fails to describe a nucleic acid with a scissile strand topoisomerase I cleavage site within 10 bases of the 3' end of the nucleic acid.

Reconsideration and withdrawal of the rejection is, therefore, respectfully requested.

**C. Wang**

Claim 2 stands rejected under §102(a) and (e) as anticipated by Wang *et al.* Applicants traverse, but in the interest of advancing the prosecution, the claim has been canceled.

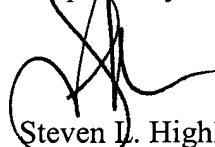
**IV. Rejection Under 35 U.S.C. §112, Second Paragraph**

Claims 4-10 and 22 stand rejected under the second paragraph of §112. The examiner questions the use of the terms “motif” and “site” without apparent distinction. Applicants have amended the term “site” to “motif,” thereby obviating the rejection. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

**V. Conclusion**

In light of the foregoing, applicant respectfully submits that all claims are in condition for allowance, and an early notification to that effect is earnestly solicited. Should the examiner have any questions regarding this response, a telephone call to the undersigned is invited.

Respectfully submitted,



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Date: December 29, 2003



Annotated Marked-up Drawings

Synthetic oligonucleotides:

T7TOPO:

5'-TAATACGACTCACTATAGGGACCCTTGGTGCACCA-3'

ASTOPO:

5'-agggtccctat-3'

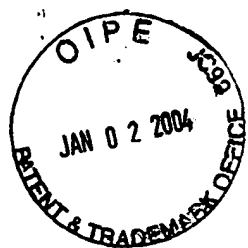
Hybridization:

TAATACGACTCACTATAGGGACCCTTGGTGCACCAagggtccctat  
|||||  
tatccctgggaACCACGTGGTCCCAGGGATATCACTCAGCATAAT

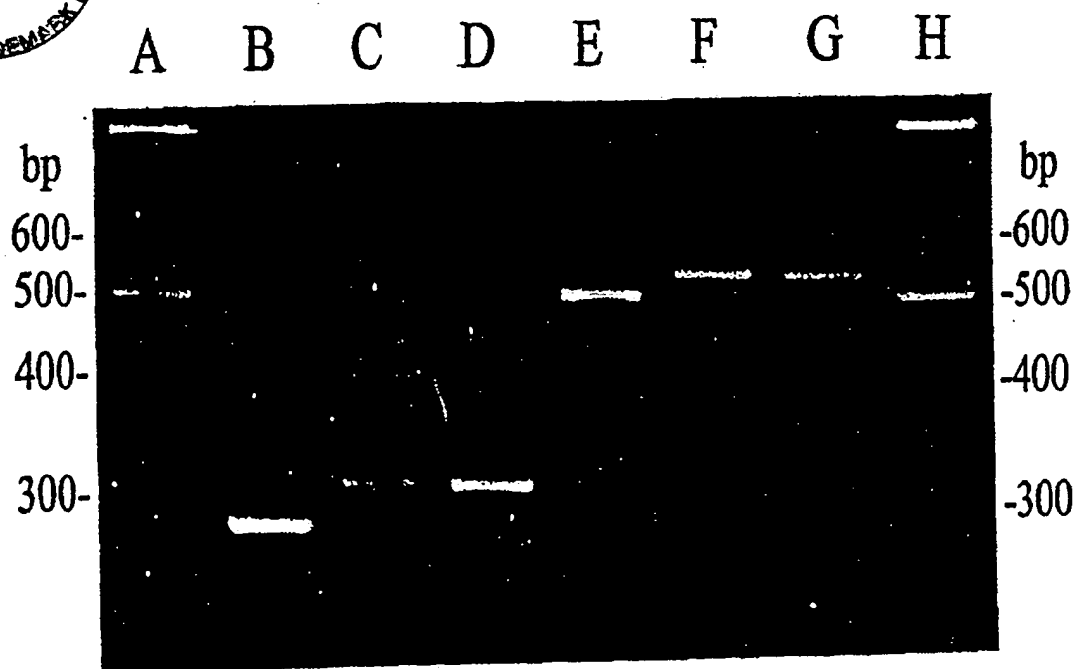
Activation with topoisomerase I:

TAATACGACTCACTATAGGGACCCTT-Topo	GGTGCACCA
TATCCCTGGGA	ACCACGTGG

~~Figure 1~~ FIG. 1



Annotated Marked-up Drawings

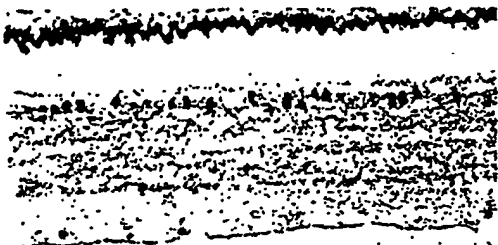


~~Figure 2~~ FIG. 2



Annotated Marked-up Drawings

A



C



B



D



~~Figure 3~~ FIG. 3